

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Giorgio De Cicco)	Group Art Unit: 3761
)	
Application No.: 10/500,336)	Examiner: Jacqueline F. Stephens
)	
Filed: June 28, 2004)	
)	
For: NON-INVASIVE DEVICE FOR)	Confirmation No.: 9867
MEASURING BLOOD)	
TEMPERATURE IN A CIRCUIT)	
FOR THE EXTRACORPOREAL)	
CIRCULATION OF BLOOD, AND)	
EQUIPMENT PROVIDED WITH)	
THIS DEVICE)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated January 11, 2008, the Examiner
required restriction under 35 U.S.C. § 121 between:

- Group I - Claims 52, 54-56, 57, 58, 64, and 71 allegedly drawn to a device for measuring blood temperature;¹
- Group II - Claims 59-63, allegedly drawn to a temperature sensor;
- Group III - Claims 65-66, allegedly drawn to a measuring device;
- Group IV - Claims 67-70, allegedly drawn to a temperature controller;

¹ As discussed below, claims 52, 57, 58, 64, and 71 were not addressed by the Examiner in the Restriction Requirement. Because these claims are directed to an invention that is patentably indistinct from that of claims 56-58, Applicants have treated them as part of Group I.

Group V - Claims 72-74, allegedly drawn to connecting portion;

Group VI - Claims 75-80, allegedly drawn to filter.

Applicants provisionally elect, with traverse, to prosecute Group I, claims 52 [sic], 54-56, 57 [sic], 58 [sic], 64 [sic], and 71 [sic], allegedly drawn to a device for measuring blood temperature. Applicants point out that it appears that the Examiner inadvertently failed to address pending claims 52, 57, 58, 64, and 71 in preparing the restriction requirement. Accordingly, Applicants have treated claims 52, 57, 58, 64, and 71 as part of Group I, allegedly drawn to a device for measuring blood temperature.

Applicants also point out that claims 59-63, which the Examiner has identified as Group II, are not directed to a temperature sensor. Applicants respectfully ask that the Examiner reevaluate this characterization of claims 59-63 and submit that claims 59-63 should be prosecuted along with the elected claims of Group I, identified above.

In the Restriction Requirement, the Examiner asserts that Groups I-VI are directed to "inventions . . . [that] do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features." (Restriction Requirement at 2.) Applicants respectfully disagree. Under 37 C.F.R. § 1.475, which governs national stage applications, Groups I-VI are one unitary invention. 37 C.F.R. § 1.475 states that:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(Emphasis added.)

Applicants submit that there is certainly a “technical relationship” between the alleged inventions in Groups I-VI. Despite the Examiner’s contention otherwise, all of the claims identified in Groups I-VI are drawn to a device for measuring blood temperature. Applicants submit that claim 52 is the only independent claim pending in this application, and every claim in Groups I-VI depends from independent claim 52. Further, even if these dependent claims represented separate inventions, PCT Rule 13.4 provides that such separate inventions are permissible if recited in dependent claims of a single application. PCT Rule 13.4 states that “[s]ubject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.” Accordingly, this restriction requirement should be withdrawn for at least this reason.

In addition, Applicants would like to draw the Examiner’s attention to the last sentence in paragraph 2 on page 2 of the Restriction Requirement, which states “[t]he particulars of the temperature sensor, connecting portion, filter, and regulating device are not required for the general blood temperature measuring device of claim 33.” Applicants believe that the Examiner’s citation of claim 33 is in error, due at least to the fact that claim 33 is no longer pending in this application. Applicants respectfully ask the Examiner to clarify the relevance of this statement to the claims currently pending in this application.

Moreover, PCT Article 27.1 states that “[n]o national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” Because similar claims were prosecuted in the international application to which this application claims benefit, and no unity of invention objection was raised (as governed by PCT Rules 13.1 and 13.2), the USPTO is precluded for now making such an objection. Accordingly, Applicants respectfully request that this restriction requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 22, 2008

By: /Aaron L. Parker/
Aaron L. Parker
Reg. No. 50,785